

REMARKS

Status of Claims

As of this Amendment, claims 1-52 are pending in this broadening reissue application, with claims 1-13 being identical to the claims that issued in U.S. Pat. No. 5,802,641, which is the patent for which broadening reissue is sought.

The Examiner's Notice of Abandonment

On April 30, 2007, the examiner mailed a Notice of Abandonment. It is respectfully requested that the examiner withdraw the Notice of Abandonment because the 2-month time limit for responding to the Board's decision of April 13, 2007 had not yet passed when the Notice of Abandonment was mailed. According to 37 C.F.R. § 1.304, "[t]he time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) is two months from the date of the decision of the Board of Patent Appeals and Interferences." Thus, the April 30, 2007 Notice of Abandonment mailed by the examiner was premature. In fact, Applicant's have a 2-month response window which ends on June 13, 2007.

Reopening of Prosecution via Submission of a Request for Continued Examination

According to 37 C.F.R. § 1.198, "[w]hen a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the authority of the Director, and then only for the consideration of matter not already adjudicated, sufficient cause being shown."

Accompanying this amendment is a Request for Continued Examination. As will be discussed in further detail herein, the claims of the present application have been amended significantly as compared to the claims considered by the Board of Patent Appeals and Interferences. Sufficient cause is believed to exist for the primary examiner to reopen prosecution of this application because, during the pendency of the appeal of this application, the Board of Patent Appeals and Interferences and the Court of Appeals for the Federal Circuit were issuing what, in essence, were contradictory decisions. In particular, the Board issued its opinion in *Ex parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003) which seemed to ameliorate

some of the harsh effects of the *Clement* test for reissue recapture (see *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997)). The Board remanded the appeal of the present application back to the examiner for reconsideration based on its opinion in *Ex parte Eggert*. Applicant interpreted that remand as a signal to the examiner that the Board believed that one or more of claims 14-100 pending in this application at the time of the remand avoided reissue recapture under one or more of the specific examples it gave in the *Ex parte Eggert* opinion. Applicant elected not to file a Response to the Examiner's Reply Brief because the *Ex parte Eggert* decision seemed to be so self-explanatory and seemed to forebode a favorable outcome with regard to at least some of claims 14-100 as they were crafted at that time. Instead, Applicant filed a paper on May 12, 2005 to advise, as a matter of courtesy, that no Response to the Examiner's Reply dated April 20, 2005 would be filed. However, the decision in *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005) was not handed down until July 14, 2005. Accordingly, Applicant did not have the opportunity to consider the ramifications of the *North American Container* decision and its effect on the Board's *Ex parte Eggert* opinion prior to the due date for the Response to Examiner's Reply to the Remand. Of course, it was also unknown to Applicant how the Board would actually apply *North American Container* in practice.

It is submitted that the state of flux in the law regarding reissue recapture, as well as the apparent disparities between the Board's view of reissue recapture and that of the Federal Circuit, is sufficient cause for prosecution to be reopened in the present application. The Amendments to the claims herein were made in a manner that are believed to properly account for the *North American Container* decision, as well as the Board's interpretation of that decision and other reissue recapture decisions as set forth in the Board's April 13, 2007 opinion in this application.

A Couple of Other Miscellaneous Issues

When the broadening reissue application was initially filed, Outside, Inc. was the corporate entity to which U.S. Pat. No. 5,802,641 was assigned. When the Appeal Brief was submitted, the "Real Party in Interest" was listed as The OR Group, Inc. In actuality, U.S. Pat. No. 5,802,641 and the present broadening reissue application are now owned by Hill-Rom Services, Inc. Assuming that prosecution is reopened in this matter, it is the intention of the

undersigned to record the appropriate papers with the U.S. Patent and Trademark Office to show the chain of title to Hill-Rom Services, Inc. and also to file a Consent of Assignee signed on behalf of Hill-Rom Services, Inc. Also, because the claims have been amended significantly herein, a new signed Reissue Declaration will be submitted at the appropriate time upon allowance of one or more of the broadening reissue claims.

It appears that the examiner considered all of the U.S. patent references that were listed on the face of U.S. Pat. No. 5,802,641 as evidenced by the PTO-892 form that accompanied the Office Action of December 26, 2001. However, the '641 patent also lists two Other Publications, namely, (1) Brouchure of O.R. Direct Surgical Table Accessories (Aug. 1996) and (2) Advertisement of Allen Medical Systems. The undersigned's file for U.S. Pat. No. 5,802,641 was transferred from another law firm and did not contain copies of those two Other Publications. It is respectfully requested that the examiner review these two Other Publications from the U.S. Patent and Trademark Office file for U.S. Pat. No. 5,802,641 and list them on a new PTO-892 sheet. If no such PTO-892 sheet appears in the next paper received from the examiner in this application, or if the examiner otherwise indicates that the examiner wishes for the undersigned to track down these documents and submit them in an Information Disclosure Statement, then the undersigned will have a third party physically copy the Other Publications from the '641 patent file at the U.S. Patent and Trademark Office to submit in an Information Disclosure Statement. An Information Disclosure Statement listing other U.S. patent references for the examiner's consideration is submitted concurrently herewith.

Explanation of the support for changes to independent claims 14, 24, 48 and 49.

Claims 14, 24, 48, 49 now each positively recites the "mounting device" and either a "leg cradle" (in the case of claim 14) or a "leg holder"(in the case of claims 24, 48 and 49). Original claim 1 included the terms "mounting device" and "leg cradle" and therefore, provides support for these recitations. The phrase "leg cradles (leg holders) 200 and 202" appears at col. 5, line 36 and provides support for the "leg holder" recitation used in claims 24, 48, and 49. The mounting device is recited to be "configured to be attached to a surgical table." Support for this aspect of the "mounting device" can be found at col. 5, lines 28-35 of the '641 with regard to the discussion of slide blocks 186, handles 190, 192, and pivot posts 34a, 34b and how slide blocks

186 couple to rails 182, 184 of an X-ray table. At col. 1, lines 13-17 of the '641, it is mentioned that a mounting clamp is known to be "located on the surgical table siderail." Support for other aspects of the leg cradle and leg holder recitations are discussed below.

The "clamping device" element has been amended in each of independent claims 14, 24, 48, and 49 to put back into the claims, with regard to this element, those limitations that the Board decision indicated were impermissibly removed as compared to original claim 1. Accordingly, support for the changes to the "clamping device" element appearing in claims 14, 24, 48, and 49 can at least be found in original claim 1. Claims 14, 24, 48, and 49 each have three "wherein" clauses that follow the initial "clamping device" clause and that pertain to further limitations of the "clamping device element." The first of these "wherein" clauses recites that the "clamping device includes a plurality of clamping elements" including "at least one first clamping device element" and "at least one second clamping device element." Support for these claim limitations, which narrow the "clamping device" element as compared to claim 1 of the original '641 patent, can be found for example, in the discussion at col. 3, lines 28-56 of the '641 patent regarding the clamp housing 30 and pressure blocks 40, 42 of clamping device 14. The second and third of these "wherein" clauses simply further clarify the "substantially simultaneously clamp" and "substantially simultaneously release" aspects of the "clamping device" recited earlier in the claim and relate these to the newly recited "at least one first clamping device element" and "at least one second clamping device element."

Claim 14 now recites "a support device having a longitudinal axis," as does original claim 1 which support this phrase. Claim 14 has been additionally amended to recite "the support device being hollow," thereby narrowing the "support device" element as compared to original claim 1. Support for this amendment can be found in the sentence at col. 3, lines 24-26 of the '641 patent which states, in part, "[s]upport device 12 includes a hollow tube 20" The similar recitations in independent claims 24 ("a support device comprising an elongated member having a longitudinal axis"), 48 ("a tube having a longitudinal axis"), and 49 ("the support device being tubular and having a longitudinal axis") are similarly supported for the reasons just enumerated.

Claim 14 has been further amended with regard to the "actuator device" element which now recites "at least one actuator device configured to move the at least one first clamping device element and the at least one second clamping device element to the respective first and

second releasing positions, at least a portion of the at least one actuator device extending within the support device.” Support for this portion of claim 14 can be found, for example, at col. 3, line 64-66 with respect to the discussion of actuator rod 84 and actuator member 86 as well as in Fig. 1 which plainly shows actuator rod 84 inside the bore of support device 12. The “actuator element” of claim 14 has been broadened in some aspects and narrowed in others, and independent claims 24, 48 and 49 omit any reference to “an actuator device,” but each of claims 14, 24, 48 and 49 are narrowed in other respects, some of which were overlooked and had not been claimed in the original prosecution and these other respects patentably distinguish over the prior art. See the Board’s April 13, 2007 decision in this application at the bottom of page 43 and the top of page 44 which explains that Federal Circuit reissue recapture jurisprudence permits broadening a previously surrendered aspect of a claim as long as the claim is materially narrowed in other overlooked, patentably distinguishing aspects.

Claim 14 has also been amended to narrow the “operator device” limitation which now recites “an operator device situated adjacent a distal end of the support device, the operator device being movable to actuate the at least one actuator device to move the first and second clamping device elements between the respective first and second releasing positions and the respective first and second clamping positions.” Support for the notion that the “operator device [is] situated adjacent a distal end of the support device” can be found, for example, at col. 3, lines 24-26 which state “[s]upport device 12 includes a hollow tube 20 which has its proximal end 22 located in clamping device 14 and its distal end at handle 18.” Figs. 1 and 4-6 clearly show that handle 18 (or handles 18a, 18b in Figs. 4-6) are adjacent the distal end of tube 20 of support device 12.

Similar recitations appearing in claim 24 (“an operator device comprising a handle coupled to the elongated member and operatively coupled to the clamping device, the coupler being positioned between the handle and the clamping device, the elongated member extending away from the clamping device beyond the coupler and the leg holder to a distal end, the handle being situated beyond the distal end of the elongated member and movable to move the first and second clamping device elements between the respective first and second clamping positions and the respective first and second releasing positions”), claim 48 (“an operator device coupled to the tube at a second distance away from the clamping device, the second distance being greater than the first distance, the tube extending away from the clamping device beyond the leg holder to a

distal end of the tube, the operator device being coupled to the tube near the distal end of the tube beyond the leg holder, the operator device being movable to move the first and second clamping device elements between the respective first and second clamping positions and the respective first and second releasing positions”) and claim 49 (“a first handle coupled to the elongated member and operatively coupled to the clamping device, the support device extending away from the clamping device beyond the leg holder to a distal end, the first handle being situated beyond the distal end of the support member and movable to move the first and second clamping device elements between the respective first and second clamping positions and the respective first and second releasing positions, and the first handle being usable to reposition the elongated member about the first and second axes after the first and second clamping device elements are moved to the respective first and second releasing positions”) are similarly supported for the reasons enumerated in the preceding paragraph.

As will be elaborated in further detail below, the fact that an operator device (in the case of claims 14 and 48) or a handle (in the case of claims 24 and 49) adjacent a distal end of the support device (in the case of claims 14 and 49) or elongated member (in the case of claim 24) or a tube (in the case of claim 48) is movable to release a clamping device to which a proximate end of the support device or elongated tube or tube (as the case may be for the particular claim) is mounted was an overlooked aspect of how original claim 1 may have been amended to patentably distinguish over the Klevstad reference (U.S. Pat. No. 4,426,071). The last clause of the “operator device” element in each of the independent claims 14, 48, and 49 (and the second to last clause of the “operator device” element of claim 24) simply relates the movement of the “operator device” (via the “at least one actuator device” in claim 14 only) to the “at least one first clamping device element” and the “at least one second clamping device element” of the recited “clamping device.”

With regard to the recitation in claim 24 that “the handle being usable to reposition the elongated member about the first and second axes after the first and second clamping device elements are moved to the respective first and second releasing positions,” support can be found, for example, at col. 5, lines 55-66 relating to the use of handles 18a, 18b to move leg cradles 200, 202.

Claim 14 has also been amended, and narrowed, with regard to the “leg cradle” element which now recites “a leg cradle supported by the support device between the operator device and

the clamping device and movable about a plurality of leg cradle axes relative to the support device, wherein the leg cradle is movable about the first plurality of axes when the support device is clamped against movement about the first and second axes.” Support this element can be found for example at col. 5, lines 35-47 pertaining to leg cradles (leg holders) 200, 202 as well as the associated support shafts 208, 210 and clamps 212, 214. The clause “a leg holder adapted to engage and support at least a portion of a leg of patient” found in claim 24; the clause “a leg holder coupled to the tube at a first distance away from the clamping device” in claim 48; and the clause “a leg holder lockable relative to the support device and releasable to move relative to the support device about a second plurality of axes” in claim 49 are each supported by this portion of the ‘641 patent either alone or in combination with Fig. 4. Each of the “leg cradle” (claim 14) and “leg holder” (claims 24, 48, 49) clauses are narrower than the passive recitation of “leg holder” in original claim 1 of the ‘641 patent.

Explanation of the support for changes to dependent claims 15-23, 25-47, and 50-52.

As stated in the Amendment filed in the present application on February 28, 2002, Agreement was reached with examiner Trettel that it is not necessary to elaborate as to the support in the original patent for each of the dependent claims of the present application. To the extent that the examiner has any questions regarding the support in the original ‘641 patent for any of the currently pending dependent claims, the undersigned would be happy to address such questions.

Substantive discussion regarding the patentability of independent claims 14, 24, 48 and 49.

As alluded to above, it is believed that there now is only one element, the “actuator device” element, which has been broadened (including completely eliminating this element in claims 24, 48 and 49) as compared to original claim 1 of the ‘641 patent. Every other element appearing in original claim 1 of the ‘641 patent (i.e., the “support device” element, the “clamping device” element, and the “operator device” element) have been narrowed. For example, in claim 14, the “support device” is now required to be “hollow;” in claim 24, the support device is required to comprise “an elongated member;” in claim 48, the generic term “support device” has been replaced by the narrower term “tube;” and in claim 49, the “support device” is required to be “tubular.” With regard to the “clamping device” element, it is now required in each of claims

14, 24, 48 and 49, to include “at least one first clamping element” and “at least one second clamping element,” thereby narrowing the “clamping device” element as compared to original claim 1 of the ‘641 patent. With regard to the “operator device” element, claim 14 requires the “operator device” be “situated adjacent a distal end of the support device,” claim 24 requires the “operator device” to comprise “a handle” that is “situated beyond a distal end of the elongated member,” claim 48 requires the “operator device” to be “coupled to the tube near the distal end of the tube beyond the leg holder,” and, in claim 49, the generic term “operator device” has been replaced by the narrower term “a first handle.”

In addition to the narrowing of the “support device,” “clamping device,” and “operator device” elements as just discussed, claims 14, 24, 48 and 49 have been further narrowed by the addition of other limitations. For example, claim 14 has been narrowed, as compared to original claim 1 of the ‘641 patent, by at least the following: (1) positively reciting the “mounting device” element and requiring it to be “configured to be attached to a surgical table,” (2) requiring “at least a portion of the at least one actuator device” to be “extending within the support device,” (3) positively reciting the “leg cradle” requiring it to be “supported by the support device between the operator device and the clamping device,” and (4) requiring that “the leg cradle is movable about the first plurality of axes when the support device is clamped against movement about the first and second axes.” It is believed that at least aspect (3) was an overlooked aspect which patentably distinguishes over the Klevstad reference (U.S. Pat. No. 4,426,071). Klevstad’s foot rest 19 and thigh rest 21 are not situated between the Klevstad’s lever 44 and Klevstad’s rotatable attachment head 37.

With regard to claim 24, it has been further narrowed, as compared to original claim 1 of the ‘641 patent, by at least the following: (1) positively reciting the “mounting device” element and requiring it to be “configured to be attached to a surgical table,” (2) positively reciting the “leg holder” and requiring it to be “pivotably coupled to the support device,” (3) the addition of the entire “coupler” recitation which is required to be “configured to couple the leg holder to the elongated member” and “configured to permit adjustment of a position of the leg holder relative to the elongated member about at least one leg holder axis,” (4) “the elongated member” is required to be “extending away from the clamping device beyond the coupler and the leg holder to a distal end,” and (5) the requirement that “the handle” be “usable to reposition the elongated member about the first and second axes after the first and second clamping device elements are

moved to the respective first and second releasing positions.” It is believed that at least aspects (4) and (5) were overlooked aspects that patentably distinguish over Klevstad. Klevstad’s shaft 39 does not extend beyond Klevstad’s foot support 19 and Klevstad’s carrying arm 56 does not extend beyond Klevstad’s thigh support 21. Is not believed that Klevstad’s lever 44 which releases Klevstad’s rotatable attachment head 37 could be used to reposition Klevstad’s shaft 39 or carrying arm 56 after the attachment head 37 is loosened.

With regard to claim 48, it has been further narrowed, as compared to original claim 1 of the ‘641 patent, by at least the following: (1) positively reciting the “mounting device” element and requiring it to be “configured to be attached to a surgical table,” (2) positively reciting the “leg holder” and requiring it to be “coupled to the tube a first distance away from the clamping device” along with the requirement that the “operator device” be “coupled to the tube at a second distance away from the clamping device,” with “the second distance being greater than the first distance,” and (3) the requirement that the “operator” device be “coupled to the tube near the distal end of the tube beyond the leg holder.” It is believed that each of aspects (2) and (3) were overlooked aspects that patentably distinguish over Klevstad. Klevstad’s foot support 19 and thigh support 21 are each located at a distance from Klevstad’s attachment head 37 that is greater than the distance from attachment head 37 that Klevstad’s lever 44 is located. Klevstad’s lever 44 is not coupled to shaft 39 beyond foot support 19 nor is Klevstad’s lever 44 coupled to carrying arm 56 beyond thigh support 21.

With regard to claim 49, it has been further narrowed, as compared to original claim 1 of the ‘641 patent, by at least the following: (1) positively reciting the “mounting device” element and requiring it to be “configured to be attached to a surgical table,” (2) the requirement that the “leg holder” be “lockable relative to the support device and releasable to move relative to the support device about a second plurality of axes,” and (3) the requirement that the “support device” be “extending away from the clamping device beyond the leg holder to a distal end,” and (4) the requirement that the “handle” be “situated beyond the distal end of the support member.” It is believed that at least aspects (3) and (4) were overlooked aspects that patentably distinguish over Klevstad. As mentioned above, Klevstad’s shaft 39 does not extend beyond Klevstad’s foot support 19 and Klevstad’s carrying arm 56 does not extend beyond Klevstad’s thigh support 21. As also mentioned above, Klevstad’s lever 44 is not coupled to shaft 39 beyond foot support 19 nor is Klevstad’s lever 44 coupled to carrying arm 56 beyond thigh support 21.

With regard to the foregoing, the examiner is reminded of the comment in the Board's April 13, 2007 decision at the top of page 27 that the *Clement* steps should not be viewed as per se rules and the examiner is also reminded of the Board's comments at the bottom of page 43 and top of page 44 which are reproduced as follows:

In summary, the recapture rule is avoided if the reissue claim was materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention:

(1) which had not been claimed and thus were overlooked during prosecution of the original patent application;^[Board's footnote omitted]
and

(2) which patentably distinguish over the prior art.

The present claims are believed to be in accordance with the above portion of the Board's April 13, 2007 decision regarding how reissue recapture can be avoided. As to the "actuator device" element, it is not believed that the amendments to that element were germane to the prior art rejection during the original prosecution. In the original prosecution, the "actuator device" element was amended by (1) amending the term "clamp" to "clamping device" so as to correct an antecedent basis error, and (2) to move the word "simultaneously" from one place in the clause to another for purposes of clarity. These changes were not made to overcome the Klevstad reference. Arguments were made, however, with regard to the "actuator device" element that were germane. Specifically, arguments were made that the "actuator device" was intended to be a single actuator device. In a broadening reissue, how is one able to broaden the argument-based type of claim narrowing to arrive at a "broadened surrendered aspect" as referred to in the page 43-44 passage of the Board's decision? Anything short of complete removal of the term risks having the narrowing argument from the original patent imported back into the broadened reissue claim. It is the intent in the present broadening reissue that the plain language of the phrase "at least one actuator device" in claim 14 trumps the argument-based narrowing of a single actuator device made during the original prosecution. However, it is

believed that complete removal of the “actuator device” element should be appropriate in the present circumstances with all of the substantial other narrowing of claims 24, 48 and 49.

Finally, there is another compelling reason why claims 14, 24, 48 and 49, as well as the associated dependent claims should be allowed. This particular fact situation (i.e., every single original claim element narrowed in some respect except one, in combination with additional narrowing recitations) is not believed to be consistent with any of the fact patterns in the reissue recapture cases cited in the Board’s opinion of April 13, 2007. Under the present fact pattern, the undersigned requests that the examiner consider the ramifications if the position is taken (by the examiner or by the Board) that the “actuator device” recitation must be put into the claims so as to be equal in breadth or narrower as compared to original claim 1 of the ‘641 patent. If this were done, this application would be, in essence, turned into a narrowing reissue application. That cannot possibly be the correct position for the examiner (or the Board) to take in this broadening reissue application.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that shortages in fees, if any, be charged, or any overpayment in fees credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 with reference to file 7175-65430.

Respectfully submitted,

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